

REMARKS

Reconsideration of the present application is respectfully requested.

The Applicants affirm the election of claims 1-38 with traverse. The remaining claims 39-51 have been withdrawn. Applicants wish to thank the Examiner for the indication that claim 35 contains patentable subject matter.

Claims 1, 5, 12, 15, 17, 19, 27, 32, 35 have been amended and claims 4, 16, 28 and 29 have been cancelled. New claim 52 has been added.

Claims 1-7, 10-11, 15-22 and 24-25 are rejected under 35 USC § 103 as being unpatentable over U.S. Patent No. 4,013,487 in view of ASM Handbook (Vol. 4). Applicants respectfully traverse the present § 103 rejections. "The PTO has the burden under section 103 to establish a prima facie case of obviousness. . . It can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fine, 837 F.2d 1071, 1074.

Independent claim 1, as amended, includes removing the nickel plating from the steel object and heat treating the steel object after the removing act. The '487 reference to Ramqvist specifically teaches applying coatings over the surface of the article to enhance corrosion resistance. More specifically, the '487 reference teaches and suggests that:

[i]n its broad aspect, the invention is directed to a process for treating steel articles to improve the physical properties thereof and resistance to corrosion, wherein a steel article is coated with a surface layer of nickel and/or cobalt and then heat treated . . . Still another advantage is that the carburized coated steel can be further improved as to corrosion resistance by applying a coating of a metal from the group consisting of Cr, Zn, Pb, Zn, Cu and Cd.

U.S. Patent 4,013,487, Col. 2, L. 30-52.

The '487 entire reference is centered on teaching the reader about the applications of coatings to enhance the corrosion resistance properties of the article. The Patent Office rejections are based upon combining the '487 reference with a general ASM Handbook. The rationale offered by the Patent Office for the proposed § 103 rejections is that "Remqvist et al. do not specify removing the nickel plating after the annealing and before further heat treating. However, it is well known in the art to conduct machining after annealing and before further heat treating acts as evidenced by the ASM Handbook (Vol. 4) (see page 714) because the annealed condition allows the steel to be easily machined." Office Action dated 10/31/05. p. 5, I 9-14. The Patent Office is impermissibly combining references and this is clearly evident by the fact that the primary teaching of the primary '487 reference is being destroyed by the proposed § 103 combination.

The Patent Office's own words recognize that the primary '487 reference does not disclose, teach or suggest removing the nickel plating from the structure. The law is well settled that the "teachings of references can be combined *only* if there is some suggestion or incentive to do so." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984). In the present case is there not only no teaching to combine the references, but the proposed combination destroys the primary teaching of the primary reference. The Examiner is respectfully requested to withdraw the § 103 rejection of claim 1 for at least the above reason.

Independent claim 15 as amended includes the acts of removing at least a portion of the electroless nickel material after said subjecting and hardening the case

region of the stainless steel object after said removing. The '487 reference to Ramqvist specifically teaches applying coatings over the surface of the article to enhance corrosion resistance. More specifically, the '487 reference teaches and suggests that:

[i]n its broad aspect, the invention is directed to a process for treating steel articles to improve the physical properties thereof and resistance to corrosion, wherein a steel article is coated with a surface layer of nickel and/or cobalt and then heat treated . . . Still another advantage is that the carburized coated steel can be further improved as to corrosion resistance by applying a coating of a metal from the group consisting of Cr, Zn, Pb, Zn, Cu and Cd.

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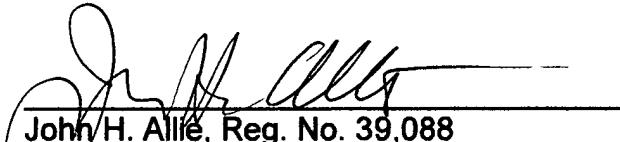
suggestion or incentive to do so." ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577 (Fed. Cir. 1984). In the present case is there not only no teaching to combine the references, but the proposed combination destroys the primary teaching of the primary reference. The Examiner is respectfully requested to withdraw the § 103 rejection of claim 15 for at least the above reason.

Independent claim 27, as amended, includes removing the nickel plating after said repeating and prior to hardening the stainless steel object. As discussed above the Patent Office has engaged in the impermissible use of hindsight in formulating the § 103 rejection of claim 27. The Examiner is respectfully requested to withdraw the § 103 rejection of claim 27 for at least the above reason.

Dependent claims 2, 3, 5 - 14, 17-26, 30 - 34, 36 – 38 and 52 are at least allowable as they depend from independent claims that are believed allowable over the asserted references.

Reconsideration of the above-identified patent application is respectfully requested. The Examiner is cordially invited to contact the undersigned by telephone to discuss any unresolved matters.

Respectfully Submitted,



John H. Allie, Reg. No. 39,088  
Krieg Devault LLP  
One Indiana Square, Suite 2800  
Indianapolis, Indiana 46204-2079  
Phone: (317) 636-4341  
Fax: (317) 238-6371